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| APPLICATION NO.     | FILING DATE                 | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------|-----------------------------|----------------------|---------------------|------------------|
| 10/713,172          | 11/14/2003                  | Aaron Partridge      | 11403/84            | 9823             |
| 26646<br>KENYON & K | 7590 07/14/200<br>ENYON LLP | EXAMINER             |                     |                  |
| ONE BROADWAY        |                             |                      | SMITH, FRANCIS P    |                  |
| NEW YORK, NY 10004  |                             |                      | ART UNIT            | PAPER NUMBER     |
|                     |                             |                      | 1792                |                  |
|                     |                             |                      |                     |                  |
|                     |                             |                      | MAIL DATE           | DELIVERY MODE    |
|                     |                             |                      | 07/14/2008          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|  | Application No.   | Applicant(s)  |  |  |  |  |
|--|---|---|--|--|--|--|
|  | 10/713,172  | PARTRIDGE ET AL.  |  |  |  |  |
| Office Action Summary  | Examiner  | Art Unit  |  |  |  |  |
|  | Francis P. Smith  | 1792  |  |  |  |  |
| The MAILING DATE of this communication app<br>Period for Reply   | ears on the cover sheet with the c  | orrespondence address   |  |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).   | ATE OF THIS COMMUNICATION 16(a). In no event, however, may a reply be tim ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI | Lely filed the mailing date of this communication. (35 U.S.C. § 133). |  |  |  |  |
| Status   |   |   |  |  |  |  |
| 1) Responsive to communication(s) filed on 14 No   | ovember 2003.   |   |  |  |  |  |
| ·= · ·   |   |   |  |  |  |  |
| ·=   |   |   |  |  |  |  |
|  |   |   |  |  |  |  |
| Disposition of Claims  |   |   |  |  |  |  |
| <ul> <li>4) ☐ Claim(s) 1-56 is/are pending in the application.</li> <li>4a) Of the above claim(s) is/are withdraw</li> <li>5) ☐ Claim(s) is/are allowed.</li> <li>6) ☐ Claim(s) is/are rejected.</li> <li>7) ☐ Claim(s) is/are objected to.</li> <li>8) ☐ Claim(s) 1-56 are subject to restriction and/or expressions.</li> </ul>  |   |   |  |  |  |  |
| Application Papers   |   |   |  |  |  |  |
| 9) The specification is objected to by the Examiner 10) The drawing(s) filed on is/are: a) access applicant may not request that any objection to the construction of the constructi | epted or b) objected to by the Edrawing(s) be held in abeyance. See on is required if the drawing(s) is obj   | ected to. See 37 CFR 1.121(d).  |  |  |  |  |
| Priority under 35 U.S.C. § 119   |   |   |  |  |  |  |
| 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the priori application from the International Bureau * See the attached detailed Office action for a list of  | s have been received. s have been received in Application ity documents have been received (PCT Rule 17.2(a)).  | on No ed in this National Stage                                       |  |  |  |  |
| Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO/SB/08)  Paper No(s)/Mail Date   | 4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:  | te  |  |  |  |  |

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## **DETAILED ACTION**

## Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-30 and 41-56, drawn to a method for forming a silicon oxide layer, classified in class 427, subclass 248.1.
- II. Claims 31-40, drawn to a method for sealing a chamber, classified in class427, subclass 331.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a silicon oxide layer formed by iteratively performing oxidizing and heating steps, or a silicon oxide layer formed with a compressive stress. The subcombination has separate utility such as creating an electromechanical device featuring a single encapsulation layer.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all

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the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

- 3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:
  - (a) the inventions have acquired a separate status in the art in view of their different classification;
  - (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
  - (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
  - (d) the prior art applicable to one invention would not likely be applicable to another invention;
  - (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C.101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis P. Smith whose telephone number is (571) 270-3717. The examiner can normally be reached on Monday through Thursday 7:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mikhail Kornakov can be reached on (571) 272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael Kornakov/ Supervisory Patent Examiner, Art Unit 1792